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EXAMINER	
SHELEHEDA, JAMES R	

ART UNIT	PAPER NUMBER
2614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/752,968	SHINTANI ET AL.	
	Examiner	Art Unit	
	James Sheleheda	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-81* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-81* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02/05/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 5, 6, 10, 11, 14-16, 27, 30-32, 36, 37, 40-42, 53, 56, 57, 59, 60, 63 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al. (Srinivasan) (6,357,042).

As to claim 1, Srinivasan discloses a method of playback of stored entertainment content (Fig. 16; column 29, lines 17-28), comprising:

notifying a service provider of a playback of the stored entertainment content (user requesting a video presentation; column 32, lines 12-15);

receiving an advertisement from an advertising server (Internet servers; column 32, lines 28-34); and

merging the advertisement with the stored entertainment content so that both the advertisement and the stored entertainment content are played back (at the client station; column 32, lines 15-21 and 32-34).

As to claim 4, Srinivasan discloses wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement (at the client station; column 32, lines 15-21 and 32-34) at a location of an advertisement place holder (inserted URL metadata; column 32, lines 22-31) forming a part of the entertainment content (column 32, lines 22-31).

As to claim 5, Srinivasan disclose wherein the inserting takes place during real time playback of the entertainment content (wherein the streams are captured and synchronized to insert the ads; column 29, lines 48-54 and column 20, lines 54-65).

As to claim 6, Srinivasan discloses wherein the stored entertainment content is stored at a service provider site (column 32, lines 12-21).

As to claim 10, Srinivasan discloses a method of delivering advertisements to a user (Fig. 16; column 29, lines 17-28), comprising:

receiving a message from a set-top box (Fig. 16; set top 229 at client station; 205) indicating initiation of playback of stored entertainment content (user at the client station requesting a video presentation; column 32, lines 12-15);

selecting an advertisement based on a user profile for the user (column 32, lines 12-15 and lines 24-31); and

transmitting the advertisement to the set-top box (from the Internet; column 32, lines 24-34) to be merged with the entertainment content (at the client station; column 32, lines 15-21 and 32-34).

As to claim 11, Srinivasan discloses merging the advertisement with the stored entertainment content (wherein the ads are played with the selected program; column 32, lines 15-21 and 32-34).

As to claim 14, Srinivasan discloses wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement (at the client station; column 32, lines 15-21 and 32-34) at a location of an advertisement place holder (inserted URL metadata; column 32, lines 22-31) forming a part of the entertainment content (column 32, lines 22-31).

As to claim 15, Srinivasan discloses wherein the inserting takes place during real time playback of the entertainment content (wherein the streams are captured and synchronized to insert the ads; column 29, lines 48-54 and column 20, lines 54-65).

As to claim 16, Srinivasan discloses wherein the stored entertainment content is stored at a service provider site (column 32, lines 12-21).

As to claim 27, Srinivasan discloses a set-top box (Fig. 16; set top 229 at client station; 205), comprising:

an input interface (Fig. 16; wherein the set-top, 229 contains an inherent interface to receive user input) receiving a signal indicating that a user has initiated a playback of stored entertainment content (column 31, lines 58-61 and column 32, lines 12-15);

means for notifying a service provider of the initiation of the playback of stored entertainment content (user requesting VOD; column 31, lines 58-61 and column 32, lines 12-15);

means for receiving a selected advertisement from the service provider (column 32, lines 12-15 and lines 32-34); and

a programmed processor (inherently present in the set-top box) that merges the selected advertisement with the entertainment content so that the entertainment content is played back with the selected advertisement (column 32, lines 22-34).

As to claim 30, Srinivasan discloses wherein the programmed processor that merges the advertisement with the stored entertainment content comprises means for inserting the advertisement (at the client station; column 32, lines 15-21 and 32-34) at a location of an advertisement place holder (inserted URL metadata; column 32, lines 22-31) forming a part of the entertainment content (column 32, lines 22-31).

As to claim 31, Srinivasan discloses wherein the inserting takes place during real time playback of the entertainment content (wherein the streams are captured and synchronized to insert the ads; column 29, lines 48-54 and column 20, lines 54-65).

As to claim 32, Srinivasan discloses wherein the stored entertainment content is stored at a service provider site (column 32, lines 12-21).

As to claim 36, Srinivasan discloses a system for delivery of advertisements (Fig. 16; column 29, lines 17-28), comprising:

means for receiving a message (at the ad server; column 32, lines 12-15) from a set-top box (229 at client station, 205) indicative of a user's selection of playback of stored entertainment content (user selection of VOD content; column 31, lines 58-61 and column 32, lines 12-15);

a user profile server (ad server) for storing a user profile of the user (column 32, lines 12-15);

an advertisement server (ad server) receiving the user profile (at subscription and occasionally updated; column 31, lines 65-67 and column 32, lines 1-2) and supplying an advertisement selected in accordance with the user profile (column 31, lines 65-67 and column 32, lines 1-2 and lines 12-15); and

means for transmitting the advertisement to the set-top box for merged playback with the entertainment content (column 32, lines 15-21).

As to claim 37, Srinivasan discloses a media server (the ad server) that merges the advertisement with the stored entertainment content (column 32, lines 15-21) before transmission to the set-top box (column 32, lines 15-21).

As to claim 40, Srinivasan discloses wherein the merging of the advertisement with the stored entertainment content is carried out by inserting the advertisement (column 32, lines 15-21) at a location of an advertisement place holder (ad insertion times; column 32, lines 15-21 and column 31, lines 16-24) forming a part of the entertainment content (column 31, lines 16-24).

As to claim 41, Srinivasan discloses wherein the inserting takes place during real time playback of the entertainment content (inserted during broadcast by the server; column 32, lines 15-21).

As to claim 42, Srinivasan discloses wherein the stored entertainment content is stored in a media server at a service provider site (data storage or other servers; column 32, lines 12-21).

As to claim 53, Srinivasan discloses an electronic storage medium storing instructions (Fig. 16; stored in set top 229, at client station; 205) which, when executed on a programmed processor (inherently present in the set-top box), carry out a process

of playback of stored entertainment content (playback of VOD; (user requesting VOD; column 31, lines 58-61 and column 32, lines 12-15), comprising:

notifying a service provider of the initiation of a playback of stored entertainment content (user requesting VOD; column 31, lines 58-61 and column 32, lines 12-15);

receiving an advertisement from an advertising server (Internet servers holding the ads; column 32, lines 12-15 and lines 32-34); and

merging the advertisement with the stored entertainment content so that both the advertisement and the stored entertainment content are played back (column 32, lines 12-15 and column 32, lines 22-34).

As to claim 56, Srinivasan discloses wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement (at the client station; column 32, lines 15-21 and 32-34) at a location of an advertisement place holder (inserted URL metadata; column 32, lines 22-31) forming a part of the entertainment content (column 32, lines 22-31).

As to claim 57, Srinivasan discloses wherein the inserting takes place during real time playback of the entertainment content (wherein the streams are captured and synchronized to insert the ads; column 29, lines 48-54 and column 20, lines 54-65).

As to claim 59, Srinivasan discloses an electronic storage medium (contained within ad server, 225) storing instructions which, when executed on a programmed

processor (inherently contained within a server), carry out a process of delivering advertisements to a user (Fig. 16; column 31, lines 58-64), comprising:

receiving a message from a set-top box (Fig. 16; set top 229 at client station; 205) indicating initiation of playback of stored entertainment content (user at the client station requesting a video presentation; column 32, lines 12-15);

selecting an advertisement based on a user profile for the user (column 32, lines 12-15 and lines 24-31); and

transmitting the advertisement to the set-top box (from the Internet; column 32, lines 24-34) to be merged with the entertainment content (at the client station; column 32, lines 15-21 and 32-34).

As to claim 60, Srinivasan discloses merging the advertisement with the stored entertainment content (wherein the ads are played with the selected program; column 32, lines 15-21 and 32-34).

As to claim 63, Srinivasan discloses wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement (at the client station; column 32, lines 15-21 and 32-34) at a location of an advertisement place holder (inserted URL metadata; column 32, lines 22-31) forming a part of the entertainment content (column 32, lines 22-31).

As to claim 64, Srinivasan discloses wherein the inserting takes place during real time playback of the entertainment content (wherein the streams are captured and synchronized to insert the ads; column 29, lines 48-54 and column 20, lines 54-65).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 7, 8, 17, 18, 33, 34, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan as applied to claims 1, 10, 27 and 36 above, and further in view of Garfinkle (5,400,402).

As to claims 7, 17 and 43, while Srinivasan discloses entertainment content stored at a server (column 32, lines 15-21) being received at a set top box (Fig. 16; set top 229 at client station; 205), he fails to specifically disclose wherein the entertainment content is stored in the set-top box.

In an analogous art, Garfinkle discloses a video on demand distribution system (Fig. 1; column 2, lines 54-61) wherein a customer site will request and download a program (column 2, lines 66-68 and column 3, lines 1-5) and then store the program in memory (20; column 3, lines 12-21) contained inside the home decoding system (Fig. 2)

for the typical benefit of allowing a user to receive and store VOD programming for viewing at a later time (column 3, lines 27-42).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include wherein the entertainment content is stored in the set-top box, as taught by Garfinkle, for the typical benefit of allowing a user of a video-on-demand system to receive and store programming for viewing at a later time.

As to claims 8, 18, 34 and 44, while Srinivasan discloses entertainment content stored at a server (column 32, lines 15-21) being received at a set top box (Fig. 16; set top 229 at client station; 205), he fails to specifically disclose wherein the entertainment content is stored in a storage device coupled to the set-top box.

In an analogous art, Garfinkle discloses a video on demand distribution system (Fig. 1; column 2, lines 54-61) wherein a customer site will request and download a program (column 2, lines 66-68 and column 3, lines 1-5) and then store the program in memory (20; column 3, lines 12-21) contained inside the home decoding system (Fig. 2) for the typical benefit of allowing a user to receive and store VOD programming for viewing at a later time (column 3, lines 27-42).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include wherein the entertainment content is stored in a storage device coupled to the set-top box, as taught

by Garfinkle, for the typical benefit of allowing a user of a video-on-demand system to receive and store programming for viewing at a later time.

As to claim 33, while Srinivasan discloses entertainment content stored at a server (column 32, lines 15-21) being received at a set top box (Fig. 16; set top 229 at client station; 205), he fails to specifically disclose a disc drive forming a part of the set-top box and wherein the entertainment content is stored in the disc drive.

In an analogous art, Garfinkle discloses a video on demand distribution system (Fig. 1; column 2, lines 54-61) wherein a customer site will request and download a program (column 2, lines 66-68 and column 3, lines 1-5) and then store the program in a disc drive (hard disk memory; column 3, lines 12-21) contained inside the home decoding system (Fig. 2) for the typical benefit of allowing a user to receive and store VOD programming for viewing at a later time (column 3, lines 27-42).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include a disc drive forming a part of the set-top box and wherein the entertainment content is stored in the disc drive, as taught by Garfinkle, for the typical benefit of allowing a user of a video-on-demand system to receive and store programming for viewing at a later time.

5. Claims 2, 3, 12, 13, 20-22, 25, 28, 29, 38, 39, 46-48, 51, 54, 55, 61, 62, 65-67 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan as

applied to claims 1, 10, 27, 36, 53 and 59 above, and further in view of Krewlin (2002/0078444).

As to claims 2, 12, 28, 54 and 61, while Srinivasan disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement (column 32, lines 22-34 and column 31, lines 10-15), he fails to specifically disclose inserting the advertisement in place of a stored advertisement forming a part of the entertainment content.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) by replacing ads present in the program with targeted advertisements (paragraphs 59 and 79) for the typical benefit of replacing previously recorded advertisements with more relevant ads (paragraphs 59 and 56).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include inserting the advertisement in place of a stored advertisement forming a part of the entertainment content, as taught by Krewlin, for the typical benefit of replacing any previously recorded advertisements with ads more relevant to a particular viewer.

As to claim 3, 13, 29, 55 and 62, Srinivasan and Krewlin disclose wherein the inserting takes place during real time playback of the entertainment content (wherein

the inserting takes place during playback of the program; see Krewlin at Second Example, paragraphs 78-80).

As to claim 38, while Srinivasan disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement (column 32, lines 15-21), he fails to specifically disclose inserting the advertisement in place of a stored advertisement forming a part of the entertainment content.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the headend will insert advertisements into recorded programming (paragraph 89) during playback (see Fifth Example; paragraphs 89-92) by replacing ads present in the program with targeted advertisements (paragraphs 59 and 92) for the typical benefit of replacing previously recorded advertisements with more relevant ads (paragraphs 59 and 56).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include inserting the advertisement in place of a stored advertisement forming a part of the entertainment content, as taught by Krewlin, for the typical benefit of replacing any previously recorded advertisements with ads more relevant to a particular viewer.

As to claim 39, Srinivasan and Krewlin disclose wherein the inserting takes place during real time playback of the entertainment content (wherein the inserting takes place during playback of the program; see Krewlin at Fifth Example, paragraphs 89-92).

As to claim 20, 46 and 65, while Srinivasan discloses selecting an advertisement (column 32, lines 12-15), he fails to specifically disclose selecting the advertisement based upon information relating to the stored entertainment content being played back.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) based upon the particular genre of the program (paragraph 61). This provides the typical benefit of allowing advertisers to determine the type of programming in which they present their advertisements.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include selecting the advertisement based upon information relating to the stored entertainment content being played back, as taught by Krewlin, for the typical benefit of allowing advertisers to target viewers by determining the specific type of programming in which they present their advertisements.

As to claim 21, 47 and 66, while Srinivasan discloses selecting an advertisement (column 32, lines 12-15), he fails to specifically disclose selecting the advertisement based upon a playback time.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded

programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) based upon the time of day (paragraph 68). This provides the typical benefit of allowing advertisers to determine the specific times of day in which they present their advertisements.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include selecting the advertisement based upon a playback time, as taught by Krewlin, for the typical benefit of allowing advertisers to target viewers by determining the specific times of day in which they present their advertisements.

As to claim 22, 48 and 67, while Srinivasan discloses selecting an advertisement (column 32, lines 12-15), he fails to specifically disclose selecting the advertisement based upon a playback date.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) based upon the date (paragraphs 66 and 67). This provides the typical benefit of allowing advertisers to determine the particular days for their advertisement to be available for viewing.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include selecting the advertisement based upon a playback date, as taught by Krewlin, for the typical benefit

of allowing advertisers to target viewers by determining the specific dates in which they present their advertisements.

As to claims 25, 51 and 69, while Srinivasan discloses selecting the advertisement based upon information relating to a profile for the user (wherein the received profile is used to choose the ad; column 31, lines 65-67 and column 32, lines 1-2 and lines 12-15), he fails to specifically disclose selecting based upon an advertising history for the user.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) based the history of previous ads presented to the viewer (paragraphs 71 and 72). This provides the typical benefit of allowing advertisers to determine how often their advertisement is display in relation to other advertisements.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include selecting based upon an advertising history for the user, as taught by Krewlin, for the typical benefit of allowing of allowing advertisers to determine how often their advertisement is displayed to a viewer relative to other inserted advertisements.

6. Claims 9, 19, 23, 24, 35, 45, 49, 50, 58 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan as applied to claims 1, 10, 27, 36, 53 and 59 above, and further in view of Hendricks et al. (Hendricks) (6,463,585).

As to claims 9, 35 and 58, while Srinivasan discloses transmitting a user profile to the service provider (column 31, lines 65-67 and column 32, lines 1-2) prior to receiving the advertisement (wherein the received profile is used to choose the ad; column 31, lines 65-67 and column 32, lines 1-2 and lines 12-15), he fails to specifically disclose transmitting a viewing history.

In an analogous art, Hendricks discloses a cable distribution system (Fig. 1) wherein a user profile including viewing history is gathered at a set top box (column 66, lines 37-51) and transmitted to a network controller (214; column 65, lines 34-53) to be gathered in a database (Fig. 24; column 65, lines 54-67 and column 66, lines 1-9) to be used to target advertisements to particular viewers (column 68, lines 48-55) for the typical benefit of more accurately targeting advertisements to interested viewers (column 68, lines 48-55).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include transmitting a viewing history, as taught by Hendricks, for the typical benefit of more accurately targeting advertisements to interested viewers through the use of a viewing history of programming of interest to the viewer.

As to claims 19 and 45, while Srinivasan discloses receiving a user profile at the service provider (column 31, lines 65-67 and column 32, lines 1-2) prior to selecting the advertisement (wherein the received profile is used to choose the ad; column 31, lines 65-67 and column 32, lines 1-2 and lines 12-15), he fails to specifically disclose receiving a viewing history from the set top box.

In an analogous art, Hendricks discloses a cable distribution system (Fig. 1) wherein a user profile including viewing history is gathered at a set top box (column 66, lines 37-51) and transmitted to a network controller (214; column 65, lines 34-53) to be gathered in a database (Fig. 24; column 65, lines 54-67 and column 66, lines 1-9) to be used to target advertisements to particular viewers (column 68, lines 48-55) for the typical benefit of more accurately targeting advertisements to interested viewers (column 68, lines 48-55).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include receiving a viewing history from the set top box, as taught by Hendricks, for the typical benefit of more accurately targeting advertisements to interested viewers through the use of a viewing history of programming of interest to the viewer.

As to claims 23, 49 and 68, while Srinivasan discloses selecting an advertisement based upon information relating to a profile of the user (wherein the received profile is used to choose the ad; column 31, lines 65-67 and column 32, lines

1-2 and lines 12-15), he fails to specifically disclose selecting an advertisement based upon a viewing history.

In an analogous art, Hendricks discloses a cable distribution system (Fig. 1) wherein a user profile including viewing history is gathered at a set top box (column 66, lines 37-51) and transmitted to a network controller (214; column 65, lines 34-53) to be gathered in a database (Fig. 24; column 65, lines 54-67 and column 66, lines 1-9) to be used to select particular advertisements to target to particular viewers (column 68, lines 48-55) for the typical benefit of more accurately targeting advertisements to interested viewers (column 68, lines 48-55).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include selecting an advertisement based upon a viewing history, as taught by Hendricks, for the typical benefit of more accurately targeting advertisements to interested viewers through the use of a viewing history of programming of interest to the viewer.

As to claims 24 and 50, Srinivasan and Hendricks disclose wherein the viewing history is transmitted from the set-top box (see Hendricks at column 66, lines 37-51) to a service provider (214; see Hendricks at column 65, lines 34-53).

7. Claims 26, 52 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan as applied to claims 10, 36 and 59 above, and further in view of Gill et al. (Gill) (2002/0083451).

As to claims 26, 52 and 70, while Srinivasan discloses selecting the advertisement based upon user profile information relating to a user (wherein the received profile is used to choose the ad; column 31, lines 65-67 and column 32, lines 1-2 and lines 12-15), he fails to specifically disclose a profile relating to a plurality of users.

In an analogous art, Gill discloses a cable television system (paragraph 35) utilizing a subscriber profile to provide targeted advertising (paragraph 39) wherein the subscriber profile relates to a plurality of users (plural subscribers in a household; paragraph 40) for the typical benefit of providing a single profile which can characterize the interests of multiple users in a household (paragraph 40).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include the use of a profile relating to a plurality of users, as taught by Gill, for the typical benefit of utilizing a single profile which can characterize the interests of every cable television user in a household receiving targeted advertising.

8. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan, in view of Dedrick (5,724,521).

As to claim 71, Srinivasan discloses a method of doing business (column 31, lines 58-64), comprising:

receiving an advertisement from an advertiser (column 32, lines 4-11);

receiving a target profile defining the type of viewer that should receive the advertisement (column 32, lines 4-7);

receiving notification from users indicative of playback of entertainment content (user at the client station requesting a video presentation; column 32, lines 12-15);

providing users with the advertisement (column 32, lines 15-21) based upon similarities between a user profile (column 31, lines 65-67 and column 32, lines 1-2) and the target profile (parameters desired by the advertiser; column 32, lines 4-11), the advertisement being provided by merging the advertisement with the entertainment content (column 32, lines 15-21).

While Srinivasan discloses calculating a charge to the advertiser (column 32, lines 7-11), he fails to specifically disclose charging based upon the number of times the advertisement is provided to users.

In an analogous art, Dedrick discloses a system for providing advertisements to particular desired viewers (Fig. 1; column 4, lines 59-67 and column 5, lines 1-4) wherein the advertiser is charged based upon the number of times the advertisement is delivered to users (column 5, lines 26-29 and column 11, lines 16-21) for the typical benefit of ensuring that advertisers pay for every showing of their advertisements (column 11, lines 16-21).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan's system to include charging based upon the number of times the advertisement is provided to users, as taught by Dedrick, for the

typical benefit of ensuring that a service provider is reimbursed by advertisers for every showing of an advertisement.

As to claim 72, Srinivasan and Dedrick disclose wherein calculating the charge based upon the times the advertisement is provided to users (wherein the advertiser is charged for each time an ad is shown; see Dedrick at column 11, lines 16-21).

As to claim 73, Srinivasan and Dedrick disclose wherein the stored entertainment content is stored at a service provider site (see Srinivasan at column 32, lines 12-21).

9. Claims 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan and Dedrick as applied to claim 71 above, and further in view of Garfinkle.

As to claim 74, while Srinivasan and Dedrick disclose entertainment content stored at a server (see Srinivasan at column 32, lines 15-21) being received at a set top box (see Srinivasan at Fig. 16; set top 229 at client station; 205), they fail to specifically disclose wherein the entertainment content is stored in the set-top box.

In an analogous art, Garfinkle discloses a video on demand distribution system (Fig. 1; column 2, lines 54-61) wherein a customer site will request and download a program (column 2, lines 66-68 and column 3, lines 1-5) and then store the program in memory (20; column 3, lines 12-21) contained inside the home decoding system (Fig. 2)

for the typical benefit of allowing a user to receive and store VOD programming for viewing at a later time (column 3, lines 27-42).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan and Dedrick's system to include wherein the entertainment content is stored in the set-top box, as taught by Garfinkle, for the typical benefit of allowing a user of a video-on-demand system to receive and store programming for viewing at a later time.

As to claim 75, while Srinivasan and Dedrick disclose entertainment content stored at a server (see Srinivasan at column 32, lines 15-21) being received at a set top box (see Srinivasan at Fig. 16; set top 229 at client station; 205), they fail to specifically disclose wherein the entertainment content is stored in a storage device coupled to the set-top box.

In an analogous art, Garfinkle discloses a video on demand distribution system (Fig. 1; column 2, lines 54-61) wherein a customer site will request and download a program (column 2, lines 66-68 and column 3, lines 1-5) and then store the program in memory (20; column 3, lines 12-21) contained inside the home decoding system (Fig. 2) for the typical benefit of allowing a user to receive and store VOD programming for viewing at a later time (column 3, lines 27-42).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan and Dedrick's system to include wherein the entertainment content is stored in a storage device coupled to the set-top box, as taught

by Garfinkle, for the typical benefit of allowing a user of a video-on-demand system to receive and store programming for viewing at a later time.

10. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan and Dedrick as applied to claim 71 above, and further in view of Hendricks.

As to claim 76, while Srinivasan and Dedrick disclose providing an advertisement based upon a profile of the user (wherein the received profile is used to choose the ad; column 31, lines 65-67 and column 32, lines 1-2 and lines 12-15), he fails to specifically disclose providing an advertisement based upon a viewing history.

In an analogous art, Hendricks discloses a cable distribution system (Fig. 1) wherein a user profile including viewing history is gathered at a set top box (column 66, lines 37-51) and transmitted to a network controller (214; column 65, lines 34-53) to be gathered in a database (Fig. 24; column 65, lines 54-67 and column 66, lines 1-9) to be used to select particular advertisements to target to particular viewers (column 68, lines 48-55) for the typical benefit of more accurately targeting advertisements to interested viewers (column 68, lines 48-55).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan and Dedrick's system to include providing an advertisement based upon a viewing history, as taught by Hendricks, for the typical benefit of more accurately targeting advertisements to interested viewers through the use of a viewing history of programming of interest to the viewer.

11. Claims 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan and Dedrick as applied to claim 71 above, and further in view of Krewlin.

As to claim 77, while Srinivasan and Dedrick disclose providing an advertisement (see Srinivasan at column 32, lines 12-15), they fail to specifically disclose providing the advertisement based upon information relating to the stored entertainment content being played back.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) based upon the particular genre of the program (paragraph 61). This provides the typical benefit of allowing advertisers to determine the type of programming in which they present their advertisements.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan and Dedrick's system to include providing the advertisement based upon information relating to the stored entertainment content being played back, as taught by Krewlin, for the typical benefit of allowing advertisers to target viewers by determining the specific type of programming in which they present their advertisements.

As to claim 78, while Srinivasan and Dedrick disclose providing an advertisement (column 32, lines 12-15), they fail to specifically disclose providing the advertisement based upon a playback time.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) based upon the time of day (paragraph 68). This provides the typical benefit of allowing advertisers to determine the specific times of day in which they present their advertisements.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan and Dedrick's system to include providing the advertisement based upon a playback time, as taught by Krewlin, for the typical benefit of allowing advertisers to target viewers by determining the specific times of day in which they present their advertisements.

As to claim 79, while Srinivasan and Dedrick disclose providing an advertisement (column 32, lines 12-15), they to specifically disclose providing the advertisement based upon a playback date.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) based upon the date (paragraphs 66 and 67). This provides the typical benefit of allowing advertisers to determine the particular days for their advertisement to be available for viewing.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan and Dedrick's system to include providing the advertisement based upon a playback date, as taught by Krewlin, for the typical benefit of allowing advertisers to target viewers by determining the specific dates in which they present their advertisements.

As to claim 80, while Srinivasan and Dedrick disclose providing the advertisement based upon information relating to a profile for the user (wherein the received profile is used to choose the ad; column 31, lines 65-67 and column 32, lines 1-2 and lines 12-15), they fail to specifically disclose providing based upon an advertising history for the user.

In an analogous art, Krewlin discloses a system for delivering advertisements (Fig. 1; paragraph 25) wherein the set top box will insert advertisements into recorded programming (paragraph 78) during playback (see Second Example; paragraphs 78-80) based the history of previous ads presented to the viewer (paragraphs 71 and 72). This provides the typical benefit of allowing advertisers to determine how often their advertisement is display in relation to other advertisements.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan and Dedrick's system to include providing based upon an advertising history for the user, as taught by Krewlin, for the typical benefit of allowing of allowing advertisers to determine how often their advertisement is displayed to a viewer relative to other inserted advertisements.

12. Claim 81 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan and Dedrick as applied to claim 71 above, and further in view of Gill.

As to claim 81, while Srinivasan and Dedrick disclose providing the advertisement based upon user profile information relating to a user (wherein the received profile is used to choose the ad; column 31, lines 65-67 and column 32, lines 1-2 and lines 12-15), they fail to specifically disclose a profile relating to a plurality of users.

In an analogous art, Gill discloses a cable television system (paragraph 35) utilizing a subscriber profile to provide targeted advertising (paragraph 39) wherein the subscriber profile relates to a plurality of users (plural subscribers in a household; paragraph 40) for the typical benefit of providing a single profile which can characterize the interests of multiple users in a household (paragraph 40).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Srinivasan and Dedrick's system to include the use of a profile relating to a plurality of users, as taught by Gill, for the typical benefit of utilizing a single profile which can characterize the interests of every cable television user in a household receiving targeted advertising.

Conclusion

13. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in

such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

_____

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

_____

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JS

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